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In re Application of :
Karin Bergstrom et al :
Serial No.: 10/642,882 : PETITION DECISION
Filed: August 18, 2003 :
Attorney Docket No.: PST6148US1/2159 :

This is in response to the petition under 37 CFR 1.181, filed June 21, 2005, requesting entry of an amendment after Final rejection and Notice of Appeal.

BACKGROUND

A review of the file history shows that the examiner mailed a non-Final Office action to applicants on June 17, 2004, setting a three month shortened statutory period for reply. The Office action held claims 5, 9-12 and 15 as withdrawn from consideration following an election made in response to a restriction requirement. The restriction requirement was made Final in the action. Claims 1-4, 6-8 and 13-14 were rejected under 35 U.S.C. 102(b) as anticipated by, or in the alternative under 35 U.S.C. 103(a) as unpatentable over Askew et al or Elliott et al. The examiner also held that the affidavit submitted March 26, 2004, was insufficient to overcome the rejections and provided reasons therefore.

Applicants filed a reply on November 16, 2004, including a request for a two month extension of time and fee therefore. Applicants replied to each ground of rejection and provided a new affidavit under 37 CFR 1.132 in an attempt to overcome the rejections. Applicants also provided a complete listing of the pending claims, including new claim 16, as required. Inadvertently a typographical error was included in the structural representation of the orthoester surfactant where a "?" appeared instead of a bond.

The examiner mailed a Final Office action to applicants on January 26, 2005, setting a three month shortened statutory period for reply. A further request to rejoin method of making claim 5 (and claims dependent thereon) was denied. The examiner set forth a new rejection under 35 U.S.C. 112, second paragraph, of claims 1-4, 6-8, 13-14 and 16 for failing to particularly point out and distinctly claim the invention, but failed to further explain the rejection. Claims 1-4, 6-8, 13-14 and 16 were also rejected under 35 U.S.C. 103(a) as unpatentable over Askew et al or Elliott et al for the same general reasons as before. The examiner withdrew the rejection under 25 U.S.C. 102(b) and further argued that the submitted affidavit partly overcame the rejection,

but not completely, referencing “n2” as being unsupported in the affidavit when it had a value of zero.

Applicants replied by submitting an amendment and argument on April 26, 2005, and a Notice of Appeal. The amendment did not alter the claims except to replace the “?” typographical error in claims 1 and 16 with a proper bond. The argument also contained a further unexecuted affidavit directed to the deficiencies of the previous affidavit. The executed affidavit was submitted May 10, 2005, prior to the mailing of the Advisory Action.

The examiner mailed an Advisory action on May 19, 2005, indicating that a Notice of Appeal had been received on April 26, 2005. The action does not indicate the status of the amendment filed with the Notice of Appeal (Boxes 3-7), but does indicate in Box 9 (see also Box 11) that the affidavit filed May 10, 2005 was not considered as it was untimely filed.

This petition followed on June 21, 2005.

DISCUSSION

Applicants petition requests entry of the amendment after Final action and consideration of the affidavit filed therewith. Also requested is clarification of the rejection under 35 U.S.C. 112, second paragraph, on the record.

With respect to the amendment of the claims, it is clear that the amendment filed November 16, 2004, which adds claim 16, contains a typographical error since the structural formula of claim 1 is repeated from the previous amendment, but differs in that it contains a “?” in place of a bond. The same error appears in added claim 16 and is again an obvious typographical error. The examiner, however, rather than pointing out the error as typographical and requesting correction thereof rejected the claims under 35 U.S.C. 112, second paragraph, but failed to explain why. The amendment submitted April 26, 2005, corrects this error and, in the sense that it places the application in better form for appeal (in that it corrects an inadvertent typographical error), should have been entered. However the examiner failed to indicate entry or non-entry of the amendment leaving applicants in virtual limbo as to the status of the claims with respect to this rejection. For this reason alone, the amendment is hereby entered.

With respect to the affidavit submitted to overcome the rejection under 35 U.S.C. 103(a) set forth in the Final Office action, the examiner considers the affidavit to be untimely contending that it was submitted after the filing of the Notice of Appeal. When referring to the executed affidavit the examiner is correct. However applicants submitted an unexecuted copy of the affidavit with the amendment with an indication that an executed copy would be filed shortly. Such was done before the examiner prepared the Advisory Action. The examiner should have considered the affidavit as timely filed since a copy was submitted prior to (or concurrently with) the filing of the Notice of Appeal. The formality of providing an executed copy merely fulfilled the requirements of the Rule. Had no executed copy been filed, the affidavit would have been considered defective, not untimely.

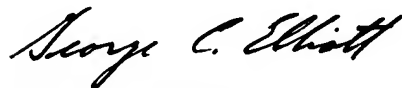
With respect to whether the affidavit responds to a new rejection, a review of the rejection set forth in the non-Final action and the one set forth in the Final action show essentially the same statement of rejection is made in both (i.e. – the references' description as to their teachings is almost verbatim). However, the arguments responding to applicants' arguments and affidavits are significantly different. The non-Final action critiques the first filed affidavit as insufficient in not providing a showing commensurate with the claims. The second affidavit critiqued in the Final action notes that it is sufficient to overcome the rejection partially and sets forth what parts are not overcome or are deficient. Thus the examiner, *sub silentio*, invited applicants to submit a further affidavit supplying the deficiencies of the submitted affidavit. For the examiner to then deny consideration of the affidavit is inappropriate.

The petition is **GRANTED**.

The Advisory action mailed May 19, 2005, is withdrawn as incomplete in failing to state the status of the amended claims and in failing to indicate the results of consideration of the affidavit. In view thereof the application will be forwarded to the examiner for prompt preparation of a new Advisory action, or other action, as appropriate.

There is no fee for this petition and the petition fee paid of \$130.00 will be credited to applicants' Deposit Account No. 01-1350, as directed.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.



George C. Elliott
Director, Technology Center 1600